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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,035	09/15/2003	Erland R. Sandstrom	02734.0560-0000	2041
31743	7590	12/02/2005	EXAMINER	
PATENT GROUP GA030-43 GEORGIA-PACIFIC CORPORATION 133 PEACHTREE STREET, N.E. ATLANTA, GA 30303-1847				FORTUNA, JOSE A
ART UNIT		PAPER NUMBER		
				1731

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/662,035	SANDSTROM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	José A. Fortuna	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 15 September 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-69 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 September 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/15/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Reissue Applications***

1. The drawings are objected since they do not meet the criteria set out in 37 CFR 1.173(b)(3). The figures have not been labeled “AMENDED” as required by part (B) of 37 C.F.R. 1.173(b)(3), reproduced below for applicants’ convenience.

One or more patent drawings shall be amended in the following manner: Any changes to a patent drawing must be submitted as a replacement sheet of drawings which shall be an attachment to the amendment document. Any replacement sheet of drawings must be in compliance with § 1.84 and shall include all of the figures appearing on the original version of the sheet, even if only one figure is amended. Amended figures must be identified as “Amended,” and any added figure must be identified as “New.” In the event that a figure is canceled, the figure must be surrounded by brackets and identified as “Canceled.” All changes to the drawing(s) shall be explained, in detail, beginning on a separate sheet accompanying the papers including the amendment to the drawings. The provisions of 37 CFR 1.173(b)(3) govern the manner of making amendments (changes) to the drawings in a reissue application. The following guidance is provided as to the procedure for amending drawings:

- (A) Amending the original or printed patent drawing sheets by physically changing or altering them is not permitted. Any request to do so should be denied.
- (B) Where a change to the drawings is desired, applicant must submit a replacement sheet for each sheet of drawings containing a Figure to be revised.

Any replacement sheet must comply with 37 CFR 1.84 and include all of the figures appearing on the original version of the sheet, even if only one figure is being amended.

**Each figure that is amended must be identified by placing the word "Amended" at the bottom of that figure, (emphasis added). Any added figure must be identified as "New." In the event that a figure is canceled, the figure must be identified as "Canceled" and also surrounded by brackets. All changes to the figure(s) must be explained, in detail, beginning on a separate sheet, which accompanies the papers including the amendment to the drawings.**

(C) If desired, applicant may include a marked-up copy of any amended drawing figure, including annotations indicating the changes made. Such a marked-up copy must be clearly labeled as "Annotated Marked-up Drawings", and it must be presented in the amendment or remarks section that explains the change to the drawings.

In addition, the examiner may desire a marked-up copy of any amended drawing figure, and so state in an Office action. A marked-up copy of any amended drawing figure, including annotations indicating the changes made, must be provided when required by the examiner.

(D) For each proper new drawing sheet being added, the new sheet should be inserted after the existing drawing sheets. For each proper \* drawing sheet >being added< which replaces an existing drawing sheet, the existing sheet should be canceled by placing the sheet face down in the file and placing a large "X" on the back of the sheet. The new sheet should be inserted in place of the turned over existing sheet.

(E) If any drawing change is not approved, or if any submitted sheet of formal drawings is not entered, the examiner will so inform the reissue applicant in the next Office action, and the examiner will set forth the reasons for the same.

*Specification*

2. The amendment filed on September 15, 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material that is not supported by the original disclosure is as follows: the change of the units of the GM Taber Stiffness constitutes a new matter, because it does not have any support in the original specification. Even though applicants state in the remarks that the units of the stiffness was wrong in the original specification and claims, this is not sufficient to establish support.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The change of the units of the GM Taber Stiffness constitutes a new matter, because it does not have any support in the original specification. Even though applicants state in the

remarks that the units of the stiffness was wrong in the original specification and claims, this is not sufficient to establish support.

Also the claims are rejected as failing to meet the requirements of 37 C.F.R. 1.173(c) since it does not explain the support in the specification.

37 CFR 1.173(c), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

***Allowable Subject Matter***

5. Claims 1-69 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach nor suggest a paperboard as claimed, i.e., the prior does not teach nor suggest a coated paperboard containing a bulk enhanced additives and having the combination of properties as claimed.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Coated paperboards."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



\_\_\_\_\_  
José A. Fortuna  
Primary Examiner  
Art Unit 1731

JAF